

EXPRESS MAIL LABEL NO. ET346777505U8

A34089 PCT USA - 069354.0101
PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert Arthur Sawhill, Jr.
Serial No. : 09/786,740
Filed : March 8, 2001
For : INTERFACE DEVICE BETWEEN TESTING
EQUIPMENT AND INTEGRATED CIRCUIT

PETITION
PURSUANT TO 37 C.F.R. §1.47(a)

I hereby certify that on the date set forth below that this paper is being deposited with the United States Postal Service "Express Mail Post Office To Addressee Service" in an envelope with sufficient postage addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on:

July 3, 2002

Date of Deposit

Paul A. Ragusa

Attorney Name

38,587

PTO Reg. No.


Signature

July 3, 2002

Date of Signature

BOX DAC

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

JUL 08 2002

OFFICE OF PETITIONS

Sir:

This is in response to the Decision on Petition under 37 C.F.R. 1.47(a) dated
February 4, 2002 ("Decision") for the above-identified application.

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The Decision vacated the erroneously issued Notice of Abandonment mailed December 6, 2001. Further, the Decision dismissed Applicants' petition under 37 C.F.R. 1.47(a), without prejudice.

In dismissing Applicants' petition, the Advisory Attorney indicated that Applicants have met all requirements of 37 C.F.R. 1.47(a), except the requirement to submit "proof of facts, namely that the inventor refuses to sign or cannot be reached after diligent effort."

Applicants herein submit that Inventor Paren Shah refuses to sign the declaration for the above-identified application. In particular, on May 24, 2002, Applicant Robert Sawhill contacted Mr. Paren Shah using Mr. Shah's electronic mail ("e-mail") address "paren_shah@hotmail.com." In an e-mail message, Applicant Sawhill informed Mr. Shah that he had previously sent Mr. Shah patent application serial number 09/786,740, and accompanying Combined Declaration and Power of Attorney document and Assignment document, for his signature to an incorrect address by mistake. Applicant Sawhill indicated that he currently had Mr. Shah's correct address and forwarded Mr. Shah the above-described materials the same day by Federal Express. Mr. Shah's correct address is 555 East El Camino Real #610, Sunnyvale, California, 94087. See Robert Sawhill's Declaration Under 37 C.F.R. 1.47(a) ("Sawhill Dec."), ¶ 2, Ex. A, attached hereto.

Then on May 30, 2002, in response to the above-described e-mail and Federal Express package (containing patent application serial number 09/786,740 and accompanying Combined Declaration and Power of Attorney document, and Assignment document), Mr. Shah replied to Applicant Sawhill's e-mail (from

"paren_shah@hotmail.com") and stated that he refused to sign any documentation without some type of monetary compensation. Mr. Shah commented that he has been previously paid a flat \$5,000.00 per patent application filed in other cases. See Sawhill Dec. ¶ 3, Ex. B. None of those other cases, for which Mr. Shah was allegedly paid, involved this group of inventors or Spire Technologies Pte. Ltd (the Assignee, once all documents are perfected). See Sawhill Dec. ¶ 3, Ex. B.

Further, Mr. Shah is contractually required to sign the declaration for the above-identified patent application. Mr. Shah signed an Employment Contract between Mr. Shah and Spire Technologies Pte. Ltd, of which Applicant Sawhill is Managing Director. The Employment Contract, executed on October 1, 1998, clearly states in "Section 9.1" that all "Inventions and Designs [developed by Mr. Shah] shall be the sole and absolute property of [Spire Technologies Pte. Ltd.]." Further, "Section 9.2" requires Mr. Shah to "execute all deeds and documents and do all such acts and things as [Spire Technologies Pte. Ltd.] may reasonably require to perfect [Spire Technologies Pte. Ltd.'s] title in the Inventions and Designs....". See Sawhill Dec. ¶ 4, Ex. C.

Having provided proof that Mr. Shah refuses to sign the declaration for the above-described application, and having provided proof that Mr. Shah is contractually required to do so, Applicant Sawhill respectfully requests that this Petition be granted to file this application on behalf of Mr. Sawhill and Mr. Shah. This Petition is accompanied by a check in the amount of \$130.00 as required under 37 CFR § 1.47(a). The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication to Deposit Account No. 02-4377. A duplicate copy of this sheet is enclosed.

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EXPRESS MAIL LABEL NO. ET346777505US

A34089 PCT USA - 069354.0101
PATENT

Respectfully submitted,

Dated: July 3, 2002


Paul A. Ragusa
Patent Office Reg. No. 38,587

BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, New York 10112-0228

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JUL 08 2002

OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee : Sawhill et al.

Serial No.: 09/786,740

Filed: 03/08/01

For : INTERFACE DEVICE BETWEEN TESTING EQUIPMENT
AND INTEGRATED CIRCUIT



Examiner: unassigned

Art Unit: unassigned

DECLARATION OF UNDER 37 C.F.R. § 1.47

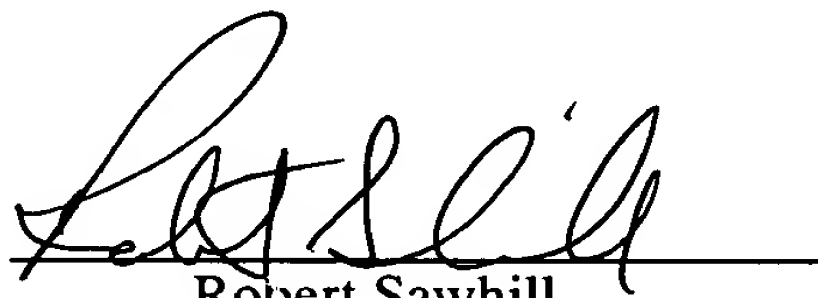
1. I, Robert Sawhill, am an employee of Spire Technologies Pte. Ltd. and currently hold the position of Managing Director.
2. On May 24, 2002, I contacted Mr. Paren Shah using his electronic mail ("e-mail") address "paren_shah@hotmail.com" informing him that I had previously sent him patent application serial number 09/786,740, and accompanying Combined Declaration and Power of Attorney document and Assignment document, for his signature to an incorrect address by mistake. I indicated that I currently had his correct address and forwarded him the above materials the same day by Federal Express. See Exhibit A attached. Mr. Shah's correct address is 555 East El Camino Real #610, Sunnyvale, California, 94087
3. On May 30, 2002, in response to the above-described e-mail and Federal Express package (containing patent application serial number 09/786,740 and accompanying Combined Declaration and Power of Attorney document, and Assignment document), Mr. Shah replied to my e-mail (from "paren_shah@hotmail.com") and stated that he refused to signed any documentation without some type of monetary compensation. He commented that he has been previously paid a flat \$5,000.00 per patent application filed in other

cases. See Exhibit B attached. None of those other cases, for which Mr. Shah was allegedly paid, involved this group of inventors or Spire Technologies Pte. Ltd (the Assignee, once all documents are perfected).

4. Attached hereto as Exhibit C is a true and accurate copy of an Employment Contract between Mr. Shah and Spire Technologies Pte. Ltd. The Employment Contract clearly states in "Section 9.1" that all "Inventions and Designs [developed by Mr. Shah] shall be the sole and absolute property of [Spire Technologies Pte. Ltd.]." Further, "Section 9.2" requires Mr. Shah to "execute all deeds and documents and do all such acts and things as [Spire Technologies Pte. Ltd.] may reasonably require to perfect [Spire Technologies Pte. Ltd.'s] title in the Inventions and Designs...."

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent involved herein.

Date: JUNE 28, 02


Robert Sawhill

>From: robert@spire.com.sg (Spire - Robert Sawhill)
>To: Tim Watkin <twatkin@lloydwise.com.sg>, Paren Shah
><paren_shah@hotmail.com>
>Subject: Total Confusion Solved
>Date: Fri, 24 May 2002 18:21:00 +0800
>
>Paren and Tim,
>
>Ok, the mystery is now solved. Paren, you never received the second
>FedEx. Our store clerk sent the documents (FP1362/aw, PCT/SG98/00068)
>to Paren Shah with the wrong address, in fact to the Internal Revenue
>Service and I just received them back from the IRS.
>
>Let me do my best to clear any confusion:
>
>PCT/SG98/0068 (Lloyd Wise reference FP1362) is the missing FedEx Paren
>never received. I have taken the liberty to quickly change Paren's
>address and nationality. Paren I have put a Post it on the two areas
>you must sign for each document. One document is the combined
>declaration/power of attorney. The other is the assignment. Lloyd Wise
>already has my signature on these documents and they are with the US
>attorney. I apologize for putting you through this Paren but this is

>extremely urgent now and if we don't get them in this week, we are going
>to default on the process and the whole thing for naught. Please sign
>these two and FedEx (feel free to use our FedEx account number) them to:
>
>Attn: Mr. Paul A. Ragusa
>Baker Botts LLP
>30 Rockefeller Plaza
>44th Floor
>New York, New York 10112-0228
>
>PCT/SG99/0048 (Lloyd Wise reference FP1464/aw) is the one Paren did
>receive and sent to Paul Ragusa because of the confusion over the two
>FedEx's, one which was never received. The combined declaration/power
>of attorney was signed by Paren but not the assignment. Paren I have
>sent a complete copy of what I received recently from Lloyd Wise and
>marked the assignment page requiring a signature. Please FedEx
>(collect) this one back to us and we will give it to Lloyd Wise here and
>they will take it from there.
>
>I'm so sorry for the inconvenience and trouble, please try to do this
>all ASAP.
>
>Thanks and Best, Robert
>

Get your FREE download of MSN Explorer at
<http://explorer.msn.com/intl.asp>.

----- Original Message -----

Subject: Re: Total Confusion Solved

Date: Thu, 30 May 2002 23:25:18 +0000

From: "Paren Shah" <paren_shah@hotmail.com>

To: robert@spire.com.sg

Robert,

I am waiting for a response from my patent atty regarding the assignment of patents-does the USPTO require the assignments along with the decl/power of atty? I have not needed to do that here in the US. During the last 2 years

I've authored and filed 3 patents and things have been fairly straightforward-no royalties or commisions on sales, but I've been paid a flat \$5K per patent application filed.

As a friend and person I've grown to respect immensely, especially after experiencing working with new "bosses" and associates, I feel a compelling obligation to assist you in any way I can. I'd be really proud if Spire does

benefit from any of my contributions, however, considering the fact that I

would never receive any benefit from sales of the vertical probe cards being patented, I would like you to propose a fair resolution of the assignment issue.

-Paren



Name: Paren Indravadan Shah

Address: 10 Rose Lane #01-01, Singapore 437370

October 1, 1998

Dear Sir

We are pleased to offer you the following terms of employment:

1. Definitions

- (a) "Group Company" means any of (i) the Company; (ii) any holding company for the time being of the Company; and (iii) any subsidiary for the time being of the Company or any such holding company; and "holding company" and "subsidiary" shall have the meanings respectively given by Section 5 of the Companies Act, Cap. 50 of Singapore;
- (b) "the Board" means the Board of Directors of the Company;
- (c) "the Employment" means the employment established by this letter.
- (d) "the Project" means the effort to produce a commercially viable Probe Card, known by the parties as a "Glass Card".
- (e) "Completion" means the Company achieving the following targets in respect of the Project: (i) ability to produce a commercially viable Glass Card; (ii) production processes fully de-bugged and documented; (iii) ability to produce the Glass Card within 7 working days using normal working hours; and (iv) the Glass Card product having booked and billed US\$1 million worth of revenue.

2. Employment

- 2.1 The Company shall employ you and you shall serve the Company as Senior R&D Engineer. The Employment shall continue unless and until terminated by either party giving to the other not less than [3] months' written notice. The Employment shall be on and subject to the terms contained in this letter.
- 2.2 In addition to the Employment, you may also be appointed to executive positions in any other Group Company. Such employment with any other Group Company shall count as part of your continuous period of employment.

3. Duties

- 3.1 (a) Your primary responsibility shall be to work on the Project.
- (b) You shall perform such other duties as may from time to time be assigned to you by the management and shall comply with all reasonable directions made by the management including, inter alia, such duties as may be required pursuant to any additional appointment as stated in Clause 2.2 subject to the articles of association of the relevant company for the time being.
- (c) You may be engaged not only to work on behalf of the Company but also to work on behalf of any other Group Company.
- 3.2 You shall act in good faith in the best interest of the Company and its shareholders, and with such care as an ordinary prudent person in a like position would use under similar circumstances and shall be loyal to the Company.

4. Remuneration and Benefits

- 4.1 Your salary during the Employment shall be at the rate of S\$7,961 per month (or at such other rate as may from time to time be agreed in writing) payable monthly on the last day of each month. This salary shall be deemed to accrue from day to day. The Company reserves the right to deduct from your salary, any amount as the Company may be entitled to deduct or as may be required by law. For convenience of administration, your salary may be paid by any Group Company, according to your duties, and at the sole discretion of the Company.
- 4.2 You shall, in respect of each financial year be entitled to [1] month's salary (or a due proportion thereof calculated on a time basis for the period of the financial year covered by the Employment) payable together with your monthly salary for December (or where the employment is terminated during a financial year, a pro-rated amount thereof, together with the last payment of your salary).
- 4.3 Upon achieving Completion of the Project, if the gross margin (ie. Revenue less direct material and labor plus applied overhead rate) on the Glass Card product is equal to or exceeds 60%, you shall be entitled, for 5 years and provided this employment agreement is subsisting, to be paid a commission of 1% on further revenue receipts from the Glass Card Product. If the gross margin is less than 60%, the commission rate will be adjusted down in an equitable way. The amount of commission due to you shall not in any event exceed US\$100,000 per year.
- 4.4 A Group Company located in the United States shall use best efforts to support an application for a US Employment pass currently named 'EB1' and pay the required fees.
- 4.5 Subject to all applicable laws and regulations having been complied with, upon Completion, a Group Company will undertake the facilitation of sponsorship and employment in the Group Company for you to continue research and development

work in the United States. The terms of employment in the United States shall commensurate with position, geographical location, etc. and shall be negotiated in good faith.

5. Annual Leave

5.1 You will be entitled to paid annual leave as follows:

- (a) 15 working days during the first year of employment;
- (b) thereafter, one (1) additional day for each year of continuous employment up to a maximum of 21 days.

5.2 Leave should be consumed by the calendar year subsequent to the year such annual leave was earned and unconsumed leave may only be carried forward to the next year with the consent of the management.

5.3 Annual leave cannot be used to offset any period of notice of termination served by you.

5.4 Payment in lieu of annual leave shall be subject to the approval of the management.

6. Insurance

6.1 The Company shall pay premiums in respect of medical expenses insurance, and life insurance effected on your behalf during the period of Employment.

7. Termination and Suspension

7.1 The Employment may be terminated by either party by notice given in accordance with Clause 2.1. The Company may pay salary in lieu of any required period of notice.

7.2 Notwithstanding the other provisions of this letter, the Company shall be entitled to terminate the Employment forthwith (but without prejudice to the rights and remedies of the Company for any breach of the terms herein and to your continuing obligations under Clause 8) in any of the following cases:

- (a) if you are guilty of dishonesty or serious or persistent misconduct, in all cases whether or not in connection with or referable to the Employment;
- (b) if you become bankrupt or have a receiving order made against you or make any general composition with your creditors;
- (c) if you neglect or refuse, without reasonable cause, to attend to the business of the Company; or
- (d) if you otherwise act in breach of this Agreement so as materially to prejudice the business of the Company.

7.3 Upon termination of the Employment for whatever reason:

- (a) you shall deliver to the Company all books, documents, papers, materials and other property relating to the business of the Company (or other Group Company) which may then be in your possession or under your power or control; and**
- (b) you shall upon request forthwith resign any position in or office of the Company or any other Group Company.**

8. Restraint on Activities of Executive

8.1 You shall keep secret and shall not at any time (whether during the Employment or after the termination of the Employment for whatever reason) use for your own or another's advantage, or reveal to any person, firm or company, any of the trade secrets, business methods or information which you knew or ought reasonably to have known to be confidential concerning the business or affairs of any Group Company so far as they shall have come to your knowledge during the Employment.

8.2 For a period of two (2) years after termination of the Employment for whatever reason, you shall not (without the previous consent in writing of the Board and whether on your own account or for any other person, firm or company) solicit or endeavour to entice away from the Company or any other Group Company any person, firm or company who or which in the preceding two (2) years shall have been a principal of the Company or any other Group Company during the Employment.

8.3 You acknowledge and agree:

- (a) that each of the foregoing sub-clauses of this condition constitutes an entirely separate and independent restriction on you;**
- (b) that the duration, extent and application of each of the restrictions are no greater than is necessary for the protection of the interests of the Company; and**
- (c) that, if any such restriction shall be adjudged by any court of competent jurisdiction to be void or unenforceable as going beyond what is reasonable in the circumstances for the protection of the interests of the Company but would be valid if part of the wording thereof was deleted and/or the period thereof was reduced and/or the area dealt with thereby was reduced, the said restriction shall apply within the jurisdiction of that court with such modifications as may be necessary to make it valid and effective.**

8.4 You shall not, at any time after termination of the Employment for whatever reason, represent yourself as being in any way connected with the Company or that of any other Group Company.

9. Inventions and Designs

9.1 If at any time during the Employment you (either alone or with others):

- (a) make or discover any invention, development, process or secret whatsoever whether patentable or not (hereinafter called "Inventions"); or
- (b) produce any work in any medium whatever including any design, model, drawing, document, plan, tape or photograph and whether in two or three dimensions (hereinafter called "Designs")

which relates to any of the products or methods of production of the Company or any other Group Company or otherwise to their businesses or which results from or is suggested by anything done in the course of the Employment, then all rights in such Inventions and Designs shall be the sole and absolute property of the Company or relevant Group Company (in case of doubt as designated by the Company) and you shall without delay communicate and deliver up to the Company all available information and materials relating to Inventions and deliver up to the Company all Designs.

9.2 You shall at the request and cost of the Company (whether during or after the end of the Employment) sign and execute all such deeds and documents and do all such acts and things as the Company may reasonably require to perfect the Company's title in the Inventions and Design, including:

- (a) to apply for, obtain and vest in the name of the Company alone (unless the Company otherwise directs) letters patent, registered designs or other protection of any nature whatsoever in respect of Inventions and Designs in any country throughout the world and, when so obtained or vested, to renew and maintain the same including, without limitation to assist the Company in any proceedings concerning the infringement of rights in Inventions or Designs; and
- (b) to defend any proceedings in respect of such applications and any petitions or applications for revocation of such letters patent, registered designs or other protection.

9.3 You shall give notice in writing to the Company promptly on becoming aware of any infringement or suspected infringement of any intellectual property right of the Company.

9.4 You shall not do or allow to be done anything which would or might prejudice any intellectual property rights of the Company.


10. Waiver of Rights

10.1 If this Agreement is terminated by either party and you are offered re-employment by the Company or employment with another Group Company on terms not less favourable in all material respects than the terms of this Agreement, you shall have no claim against the Company in respect of such termination or at all.

11. Miscellaneous

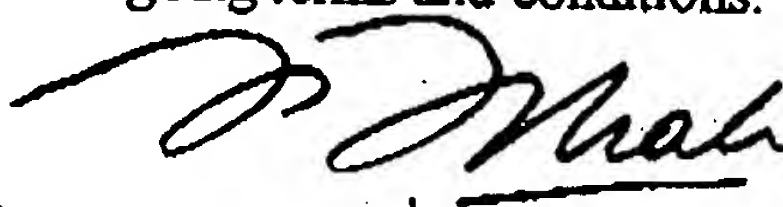
- 11.1 This letter shall from the the date of this letter operate in substitution for any terms of service previously in force between the Company and you, but without prejudice to the rights, liabilities and obligations (if any) of either party accrued prior to that date. This letter constitutes the entire agreement and understanding between the parties as to its subject matter and you acknowledge that you have not entered into this letter in reliance upon any representation, warranty or undertaking which is not set out in this letter or referred to in this letter as forming part of the contract of your employment.
- 11.2 The various provisions of this letter are severable and if any provision is held to be invalid or unenforceable by any court of competent jurisdiction then such invalidity or unenforceability shall not affect the remaining provisions of this letter.
- 11.3 Any notice to be given hereunder to you may be served by being handed to you personally or by being sent by recorded delivery first class post to you at your usual or last known address; and any notice to be given to the Company may be served by being left at or sent by recorded delivery first class post to its registered office for the time being. Any notice served by post shall be deemed to have been served on the day (excluding Sundays and statutory holidays) next following the date of posting and in proving such service it shall be sufficient proof that the envelope containing the notice was properly addressed and posted as a prepaid letter by recorded delivery first class post.
- 11.4 This letter shall be governed by and construed in accordance with the laws of Singapore.

Yours faithfully
For and on behalf of
Spire Technologies Pte Ltd



Teresa Sng

I hereby agree with and accept
the foregoing terms and conditions:



Paren Indravadan Shah

Oct. 1, 98
Date:

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